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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,156	12/12/2003	Bertrand Lion	LOREAL 3.0-002; OA02420/U	3506
530 7590 10/23/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 10/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,156	Applicant(s) LION, BERTRAND	
	Examiner James W. Rogers, Ph.D.	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 13-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10-12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/27/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Currently claims 1,3-27 are pending, claims 5-9 and 13-14 have been withdrawn previously by restriction/election species.

Response to Arguments

Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, filed 09/07/2007, have been fully considered and are persuasive. Neither the Seabag or Mouglin reference discloses a non-aqueous, non-silicone fluid of at least 50% of the composition within applicants claimed solubility parameters. The monoalcohols disclosed within the above patents do not have the same solubility parameter and the adjuncts such as fatty oils cannot reasonably be considered as a solvent that would be used in amounts of over 50% of the composition. The rejections have therefore been withdrawn. However a new rejection is made below which was necessitated by applicants newly filed IDS.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,3-4,10-12, 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midha et al. (WO 97/33556), this new rejection was necessitated by applicants newly disclosed IDS filed 09/27/2007.

Midha discloses personal care compositions that can be in the form of dispersed particles of a copolymer in a hydrophobic volatile solvent. See abstract and pag 17 lin 31-35. The copolymer is a graft copolymer composed of 30-95% by weight of (A) a backbone that includes methyl methacrylate and 5-70 % by weight of (B) macromonomer side chains including isobutylene and butadiene, the macromonomer can further be endcapped with an acrylate. See pag 2 lin 29-pag 4 lin 19, pag 9 lin 1-pag 15 lin 14 and claims. The MW of the macromonomer was most preferably from about 2,000 to about 25,000, higher than 200 as required in claim 1 and within the claimed ranges within claims 11-12. Regarding the limitation within claim 1 that the non-

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aqueous non-silicone liquid having a global solubility parameter less than 17, Midha teaches that the hydrophobic volatile solvent can be a branched chain hydrocarbon such as isododecane, a solvent that applicants specifically recite meets their claimed solubility parameter. See pag16 lin 14-pag 17 lin 10 and [0030] within US 2004/0156812 A1. Midha also discloses hair care compositions with a carrier (including lower alcohols) that also comprises a fatty alcohol such as cetyl and stearyl alcohols, two alcohols that meet applicants claimed solubility parameter. See pag 17 lin 19- pag18 lin 19 and [0035] within US 2004/0156812 A1. The amount of hydrophobic volatile solvent could comprise 0.1 to 75% of the composition, thus from this broad range it would have been obvious to one of ordinary skill in the art that an amount of at least 50% of the solvent could be used in the composition. Regarding claims 17-18 Midha discloses that the amount of macromonomer could be from 5-70% by weight of the copolymer, thus from this broad range it would have been obvious to one of ordinary skill in the art that the macromonomers could be used within applicants claimed range. Regarding claims 19 and 20, Medha discloses several examples of the finished copolymers that would have acrylic backbones within applicants claimed range, See pag 15 lin 3-14. Regarding claim 22 Medha discloses that the amount of copolymer in the compositions could be from about 0.1 to about 25%, thus from this broad range it would have been obvious to one of ordinary skill in the art that the amount of solid (copolymer) could be within applicants claimed range. Regarding claim 22 since the copolymers of Medha are essentially the same as applicants claimed polymers and are within the same MW range it is obvious that such polymers will form particles with the same diameters. From

applicants own specification at [0101] of US 2004/0156812 A1 "polymers of the invention have the capacity of folding over on themselves, thus forming solid particles of substantially spherical shape, the periphery of these solid particles having the deployed side chains, which ensure the stability of these particles. Such particles resulting from the characteristics of the polymers of the invention have the particular feature of not aggregating in the said medium and thus of being self-stabilized and of forming a particularly stable polymer particle dispersion". Thus from applicants own specification it appears that any polymer that is substantially the same as their claimed polymer will have the ability to form particles in the same matter.

Conclusion

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER